

### **REMARKS**

Claims 28-45 are pending in the present application and claims 30 and 38-45 have been withdrawn from consideration.

#### **Information Disclosure Statement**

In the Office Action, the Examiner indicated that the IDS filed on October 22, 2001 failed to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each foreign patent and publication. Applicants point out that pursuant to 37 CFR 1.98(d), copies of such documents are not required to be submitted in the present application since such documents were previously submitted in the parent application, 09/457,254, which was properly identified in the IDS of October 22, 2001 and is relied upon for an earlier effective filing date under 35 U.S.C. 120. Applicants therefore submit that the previously submitted IDS was proper.

#### **Rejection of Claims Under 35 U.S.C. 102**

Claims 28, 29, and 31-37 stand rejected as being allegedly anticipated by U.S. Patent No. 5,464,395 to Faxom ("Faxom") and U.S. Patent No. 5,419,777 to Hofling ("Hofling"). Claims 28-29 and 31-32 stand rejected as being allegedly anticipated by U.S. Patent No. 4,578,061 to Lemelson ("Lemelson"). Claims 28-31 stand rejected as being allegedly anticipated by U.S. Patent No. 5,728,143 to Gough ("Gough"). Applicants respectfully traverse these rejections as none of the cited references, which are each discussed below in turn, teach or suggest an "at least one secondary member [that] is retractable to a position within [a] primary penetrating member," as recited either directly or indirectly in all the present claims.

With respect to Faxom, this reference describes "needle cannulas" with "tissue-piercing tips" that are slidably disposed within the lumen of a catheter. Although multiple needle cannulas are described in Faxom, there is absolutely no description of a second needle cannula that is retractable to a position within a first needle cannula or any other component or portion of the catheter that can penetrate tissue. Accordingly, Applicants submit that Faxom does not teach or suggest an "at least one secondary member [that] is retractable to a position within [a] primary penetrating member," as

recited in the present claims. The Examiner refers to element 50 in Faxom as being a "primary penetrating member." However, as described in Faxom, element 50 is a "blunt conical nose portion" that is used to facilitate movement of catheter 5 (see col. 5, lines 43-45). Therefore, rather than having a sharpened end, nose portion 50 is blunt and rather than being able to penetrate tissue, nose portion 50 is used facilitate movement of the catheter. Accordingly, nose portion 50 is not a "primary penetrating member," and thus Hofling does not teach or suggest an "at least one secondary member [that] is retractable to a position within [a] primary penetrating member," as recited either directly or indirectly in all the present claims.

Similarly with respect to Hofling, this reference describes an injection catheter including a catheter tip and a bundle of injection needles. The catheter tip is axially moveable in a sleeve which is connected to a multi-lumen stem having injection needles secured within various lumina. None of the injection needles, however, are retractable within any of the other injection needles or any other component or portion of the catheter that can penetrate tissue. The Examiner refers to element 11 in Hofling as being a "primary penetrating member." However, element 11 refers to the catheter tip which is illustrated in all the drawings as being blunt and is not at all described as being capable of penetrating tissue. The only components of the catheter of Hofling that are described as being able to penetrate tissue are the injection needles (see col. 4, lines 66-68). Therefore, Hofling does not teach or suggest an "at least one secondary member [that] is retractable to a position within [a] primary penetrating member," as recited in the present claims.

With respect to Lemelson, this reference describes a catheter having a hollow needle moveably supported within the head of the catheter. Similar to the other references described above, Lemelson does not describe the hollow needle being retractable to a position within any component or portion of the catheter that can penetrate tissue and thus be considered a "primary penetrating member." Therefore, Lemelson does not teach or suggest "at least one secondary member [that] is retractable to a position within [a] primary penetrating member," as recited in the present claims.

Lastly, with respect to Gough, this reference describes a multiple antenna ablation apparatus having antennas that can be advanced from a trocar. There is absolutely no

description in Gough that these antennas have sharpened ends and are capable of penetrating tissue. Rather, these antennas are described as delivering electromagnetic energy to tissue mass (see col. 4, lines 58-60) or being used to infuse medium to selected places within the tissue mass (see col. 8, lines 21-31). Such description, however, does not indicate that the antennas can penetrate tissue and therefore can be considered "secondary penetrating members," as recited in the present claims. Therefore, Gough does not teach or suggest an "at least one secondary member [that] is retractable to a position within [a] primary penetrating member," as recited in the present claims. For at least these reasons, Applicants respectfully request withdrawal of the rejections of the present claims as being anticipated by Faxom, Hofling, Lemelson, or Gough.

### CONCLUSION

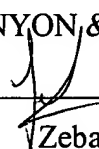
It is respectfully submitted that the present application is now in condition for allowance, which action is respectfully requested. The Examiner is invited to contact Applicant's representative to discuss any issue that would expedite allowance of the subject application.

It is not believed that any extensions of time or other fees are required in connection with the filing of this response. However, if any fees for extension(s) of time or additional fees are required in connection with the filing of this response, such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is authorized to charge any such required fees or to credit any overpayment to Kenyon & Kenyon's Deposit Account No. 11-0600.

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